

REMARKS

The present application includes 71 claims, 33 of which are independent. The Examiner has restricted the instant application to a patentable distinct species of the claimed inventions groups by the Examiner as:

- I. Species of the embodiment disclosed corresponding to claims 1-24, 31-33, 52, 57 and 58 (*A method of associating a digital electronic version of a printed document with position-determining code*)
- II. Species of the embodiment disclosed corresponding to claims 25-30, 53, 54 and 67-69 (*Sheet(s) of paper with position-determining code*)
- III. Species of the embodiment disclosed corresponding to claims 34-37 (*A network utilizing digital paper with position information*)
- IV. Species of the embodiment disclosed corresponding to claims 38-42, 46, 59-62, 64 and 71 (*An apparatus to print documents with human readable content and digital pen-readable position pattern information*)
- V. Species of the embodiment disclosed corresponding to claims 43-45 (*Data sets*)
- VI. Species of the embodiment disclosed corresponding to claims 47 and 48 (*Method of producing paper with position-determining code*)
- VII. Species of the embodiment disclosed corresponding to claims 49-51 (*Method of combining pen strokes upon paper with digital position-determining code with electronic version of paper*)
- VIII. Species of the embodiment disclosed corresponding to claims 55, 56, 63, 65, 66 and 70 (*Apparatus adapted to associate printed digital pattern with equivalent documents*)

The Examiner contends that the inventions are independent or distinct because claims to different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record. Emphasis added, Office Action Page 2.

It is respectfully noted although the Examiner asserts that the claims fall to different classes/subclasses, the Examiner has offered no finding as to which different classes/subclasses are at issue. In preparing this response, notations have been provided in italics generalizing the nature of each identified species for assistance in identifying and relating the present claims set.

It is respectfully noted that 35 U.S.C. 121, the law, states in relevant part: "If two or more **independent AND distinct** inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." Emphasis added. Note that 37

C.F.R. §§ 1.141 and 1.142 also speak of "independent and distinct" inventions. ***The Examiner has only argued that the inventions are distinct or distinct but not which or both as the law requires.*** Therefore, the restriction requirement is improper and Applicants request that it be withdrawn.

Note that Applicants do not consider the explanation of the meaning of "independent" and "distinct" in MPEP §802.01 persuasive. The MPEP §802.01 Meaning of "Independent" and "Distinct":

"35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent", of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that 35 U.S.C. 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended."

The arguments presented in the MPEP appear to rest on two pillars:

- 1) Apparently, the novel statutory construction theory being put forward is that in the absence of legislative history on a given point, the law doesn't mean what the law says. Applicant submits that the statutory construction as described by the Supreme Court should be given deference: "[I]n interpreting a statute a court should always turn to one cardinal canon before all others. . . . [C]ourts must presume that a legislature says in a statute what it means and means in a statute what it says there." Certainly, "[w]hen the words of a statute are unambiguous, then, this first canon is also the last: 'judicial inquiry is complete.'" *Id.*
- 2) "Independent and distinct" has the same meaning as "distinct." This is a logical impossibility if "independent" and "distinct" have different definitions, and clearly MPEP §802.01 concedes that that they do have different definitions and helpfully provides them.

With respect, Applicants suggest that the Examiner has not satisfied 35 U.S.C 121 in the restriction requirement; therefore, the requirement should be withdrawn. If the Examiner wishes to maintain the restriction requirement, the Applicants respectfully request that the Examiner also explain how the subject matter represents two "independent" inventions, according to the definition of "independent" given in MPEP §802.01.

The Examiner's classification of Species I relates generally to the associating a digital electronic version of a printed document, e.g. a sheet of paper, with position-determining code.

It is unclear how or why the claims of Species I which relate to the method, a printer employed in such a method, and sheets of paper presenting the position-determining code pattern for use in the method, and other elements are truly independent and distinct from the other identified species, most specifically:

- the Paper with such position-determining code provided by Species II;
- the apparatus (e.g. printer) to print the documents provided by Species IV;
- the method of producing the paper with the position-determining code provided by Species VI;
- the method of combining pen strokes upon paper with the digital code with an electronic version of the paper provided by Species VII; or
- the apparatus adapted to associate the printed digital pattern with equivalent documents provided by Species VIII.

Moreover, the restriction requirement is improper as the Examiner has only argued that the inventions presented are independent or distinct, but offers no reasoning or justification as to exactly how and why, let alone that the truly independent **AND** distinct.

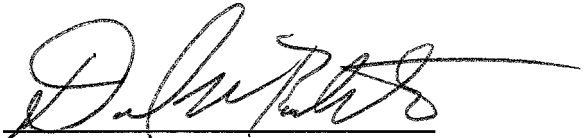
Applicant thus provisionally elects, with traverse, Species I, claims 1-24, 31, 33, 52, 57 and 58, and provisionally withdraws the claims of Species II – VIII (Claims 25-30, 32, 34-51, 53-56 and 59-71).

Applicant has fully responded to Examiner's concerns as presented in the Request for Restriction of March 27, 2008. If Species I and II – VIII are indeed held to be independent **AND** distinct inventions, Applicant may file continuing applications pursuing the claims of Species II – Species VII (Claims 25-30, 32, 34-51, 53-56 and 59-71).

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant believes that no fees are currently due; however, should any fee be deemed necessary in connection with this Amendment and Response, the Commissioner is authorized to charge deposit account 08-2025, referencing the Attorney docket number 200208339-1.

Respectfully submitted,

By: 
Daniel W. Roberts, Reg. No. 52,172
Law Offices of Daniel W. Roberts
904 Topaz Street
Superior, Colorado 80027
Telephone: (720) 304-3026